

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MBHB Docket No. 08-506

In the Application of:)	
)	
Aaftab A. Munshi et al.)	
)	
Application No.: 09/472,100)	Patent No.: 7,209,889
)	
Filing Date: December 20, 1999)	Issue Date: April 24, 2007
)	
For: Secure System for the Issuance,)	
Acquisition, and Redemption of)	
Certificates in a Transaction Network)	

Mail Stop Certificate of Correction
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CERTIFICATE OF CORRECTION

Dear Sir:

Applicant respectfully requests that the Office issue the attached Certificate of Correction in the above-captioned case to correct the priority claim to U.S. Provisional Application No. 60/113,706 ('706 Provisional) under 35 U.S.C. 120. In particular, the Declaration for U.S. Application No. 09/472,100 ('100 Application), which issued as U.S. Patent No. 7,209,889 ('889 Patent), claims priority to the '706 Provisional. A copy of the Declaration is submitted herewith. Applicant thus timely claimed priority in the Declaration. However, priority was not claimed in the Application Data Sheet or in the Specification, and Applicant failed to amend the specification to include a reference to the '706 Provisional in the first sentence following the title

as required by MPEP 201.11 and 37 CFR 1.78. Applicant therefore seeks to correct this omission with the present Certificate of Correction.

Under MPEP 1481.03, “a Certificate of Correction can...be used, with respect to 35 U.S.C. 120 priority, to correct...the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2) and (a)(4).” In this case, Applicants have failed to properly make reference to the ‘706 Provisional as specified by 37 CFR 1.78(a)(4), which requires that:

Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number). Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following any title.

In this scenario, MPEP 1481.03 requires that: (1) “for 35 U.S.C. 120 priority, all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected” and (2) “it must be clear from the record of the patent and the parent application(s) that priority is appropriate.” MPEP 1481.03 further provides that if these “conditions are satisfied, a Certificate of Correction can be used to amend the patent to make reference to a prior copending application, or to correct an incorrect reference to the prior copending application.”

First, Applicant submits that all requirements under 37 CFR 1.78(a)(1) have been met in the ‘100 Application. Second, Applicant submits that it is clear from the record that priority is appropriate because: (i) the Declaration for the ‘100 Application claims priority to the ‘706 Application, (ii) the ‘706 Provisional names the same inventor as the ‘100 Application (Henry Whitfield), (iii) the subject matter of the ‘706 Provisional meets 112 requirements for at least one claim of the ‘100 Application.

In view of the foregoing, Applicants respectfully request that the attached Certificate of Correction be issued in the present case.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff LLP

Date: April 30, 2010

By: /Michael D. Clifford/
Michael D. Clifford
Registration No. 60,550

DECLARATION FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name;

I believe I am the original, first, and sole inventor (if only one name is listed below) or an original, first, and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

SECURE SYSTEM FOR THE ISSUANCE, ACQUISITION, AND REDEMPTION OF CERTIFICATES IN A TRANSACTION NETWORK

the specification of which (check one) ☒ is attached hereto, or ☐ was filed on _____ as Application Serial No. _____ and was amended on _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)

Priority Claimed
Yes No

Number Country Day/Month/Year Filed

Number Country Day/Month/Year Filed

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

MICHAEL A. GLENN, Reg. No. 30,176
DONALD M. HENDRICKS, Reg. No. 40,355
KIRK D. WONG, REG. NO. 43,284
EARLE W. JENNINGS, Reg. No. 44,804
CHRISTOPHER PEIL, Reg. No. 45,005

SEND CORRESPONDENCE TO:

MICHAEL A. GLENN, 125 LAKE ROAD, PORTOLA VALLEY, CA 94028

I hereby claim the benefit under Title 35, United States code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

<u>60/113,706</u>	<u>12/24/98</u>	<u>PROVISIONAL</u>
Application Ser. No.	Filing Date	Status: Patented, Pending, Abandoned

<u> </u>	<u> </u>	<u> </u>
Application Ser. No.	Filing Date	Status: Patented, Pending, Abandoned

=====

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor: HENRY WHITFIELD

Inventor's signature *Henry Whitfield* 12/10/99
Date

Residence 2490 Agnes Way, Palo Alto, California 94303

Post Office Address Same

Citizenship United States of America

**STATEMENT CLAIMING SMALL ENTITY STATUS
(37 CFR 1.9(f) & 1.27(b))--INDEPENDENT INVENTOR**

Docket Number (Optional)
ADEX0001

Applicant, Patentee, or Identifier: Whitfield

Application or Patent No.: Unassigned

Filed or Issued: Herewith

Title: Secure System for the Issuance, Acquisition, and Redemption of Certificates in a Transaction Network

As a below named inventor, I hereby state that I qualify as an independent inventor as defined in 37 CFR 1.9(c) for purposes of paying reduced fees to the Patent and Trademark Office described in:

- ☒ the specification filed herewith with title as listed above.
☐ the application identified above.
☐ the patent identified above.

I have not assigned, granted, conveyed, or licensed, and am under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person had made the invention, or to any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

Each person, concern, or organization to which I have assigned, granted, conveyed, or licensed or am under an obligation under contract or law to assign, grant, convey, or license any rights in the invention is listed below:

- ☒ No such person, concern, or organization exists.
☐ Each such person, concern, or organization is listed below.

Separate statements are required from each named person, concern, or organization having rights to the invention stating their status as small entities. (37 CFR 1.27)

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))

Henry Whitfield
NAME OF INVENTOR

NAME OF INVENTOR

NAME OF INVENTOR

Henry Whitfield
Signature of inventor

Signature of inventor

Signature of inventor

12/20/99
Date

Date

Date

Secure Method & Process for the Issuance, Purchase, & Redemption of Certificates In A Transaction Network

A certificate issuer [Fig 1-11] in selective electronic communication with a certificate authority [Fig 1-2] has the means [Fig 1-5] to direct the certificate authority to create a customized virtual certificate [Fig 2] and/or create multiple and/or varying virtual certificates, for subsequent issuance to acquirers purchasing and/or otherwise qualifying for issuance.

An issuer has the means [Fig 5-7] to control the modular design of each certificate independently either by selecting standard designs offered by the certificate authority, by uploading the issuer's custom design and/or designs [Fig 2-2] to the certificate authority in the form of a computer file, or by specifying that a certificate be issued using a combination of stock elements provided by the certificate authority merged with custom elements uploaded by the issuer.

Each certificate exists, until issued, as a virtual certificate comprised of multiple independent textual and/or graphical elements stored by the certificate authority in a secure database [Fig 1-1].

Upon issuance of instructions by an acquirer [Fig 1-9] in selective electronic communication with the certificate authority, an entire certificate [Fig 2] is constituted from the independent data elements for a certificate stored in the secure database, for presentation to the acquirer on a video display; for example, in the form of an HTML document readable by an internet browser.

Upon instructions from an acquirer to the certificate authority by means of the acquirer facilities [Fig 1-4], the certificate authority issues a certificate to the issuer, assigning in the transaction process a unique identifier to the issued certificate comprised of a secret public key which appears on the certificate [Fig 3-3] in combination with a private key assigned to the certificate by the acquirer [Fig 3-1] as a part of the transaction. This key does not appear on the certificate, and is known only to the acquirer, but is stored by the certificate authority in association with the other data elements relating to the certificate on the secure database.

Optionally, an issuer may elect to incorporate the denomination of the certificate [Fig 2-3] as an additional element in the public key [Fig 3-2].

Optionally, an issuer may also elect to incorporate an additional element as a part of the public key [Fig 3-4]. This could be useful, for example, in mapping a certificate to an issuer's existing coding scheme.

Subsequently, a redeemer [Fig 1-12] in communication with the certificate authority by means of the redeemer facilities [Fig 1-6], or optionally, by means of live operator intermediary [Fig 1-14] may authenticate a certificate by providing [Fig 4], the certificate authority with the unique public identification information associated with the certificate [i.e., the public key assigned to the certificate on issuance] and the unique private identification information which is assigned to the certificate by the acquirer [ie, the private key]. This key must be provided to the redeemer as part of the redemption transaction by the acquirer [Fig 4-2], or by a third party and/or agent to whom the acquirer has communicated the private key.

The certificate authority authenticates a certificate on the basis of the keys submitted by a redeemer, by querying its secure database which stores the independent elements associated with the certificate, to determine whether the the matched public key/private key pair originally associated with the certificate on issuance matches the public key/private key identification information provided to the certificate authority by the redeemer [Fig 4-6]. If the unique identification sets correlate, the certificate authority validates the certificate, and upon instructions from the redeemer, authorizes the redemption transaction [Fig 4-7]. Upon authorization of the certificate, the certificate authority revokes the certificate by updating the certificate information stored on the secure database, and initiates by means of its payment facilities [Fig 1-3] the process of transferring payments among the parties to the transaction by issuing transfer instructions to it's payment agent [Fig 1-20] and the payment agents of the issuer [Fig 1-18], the acquirer [Fig 1-17], and the redeemer [Fig 1-19].

An issuer in a secure communication [Fig 5-3] with the certificate authority and by means of issuer facilities [Fig 1-5, Fig 5-2] can upload other discrete data elements unique to the issuer to the certificate authority for storage as stored elements associated with a certificate, or otherwise direct certificate parameters by selection of options offered by the certificate authority:

Optionally, this may include information on the denomination of the certificate [Fig 5-6]. The denomination may be in the form of a currency denomination, or in the form of a code associated with a product, a service, a coupon, a voucher, or other instrument, for which the certificate may be redeemed.

Optionally, this may include information on the issuer, such as company information, promotional copy, and the like [Fig 5-5].

Optionally, this may include graphics unique to the issuer in the form of computer graphics files associated with an issuer and/or a product or service [Fig 2-2].

Optionally, this may include information regarding rules governing redemption, which optionally may include an expiration date, exclusion of redeemers on the basis of geographic location, or other rules unique to the issuer [Fig 5-8, Fig 2-4]

Optionally, an issuer can direct the certificate authority to limit the number of virtual certificates to be issued by the certificate authority on behalf of the issuer within a time frame, within a geographic region, or on the basis of other criteria unique to the issuer [Fig 5-9].

Optionally, an issuer may specify that the format of unique certificate identification information [Fig 5-10, Fig 3-4] include additional unique identification information, to be combined with identification information assigned by the certificate authority.

Optionally, an issuer may authorize [Fig 5-10] the certificate authority to issue certificates within a set range of face values, and/or authorize creation of virtual certificates with a value determined by an acquirer, and/or authorize creation of certificates which may be redeemed for specific items and/or services, as described by product identification numbers and/or other descriptive information specified by the issuer.

Examples of certificates that can be offered to acquirers by the certificate authority on behalf of issuers include certificates denominated as full payment in exchange for an item and/or service [for example, a gift certificate redeemable for an item and/or service, or a ticket or coupon voucher redeemable for an actual ticket]; certificates which may be redeemed as partial payment for a particular item or service, denominated as a currency amount [for example, a gift certificate denominated in a currency amount]; or a certificate redeemable for currency, denominated in a currency amount [for example, a “traveler’s check.”].

An issuer in a secure communication [Fig 5-3] with the certificate authority is further provided the means [Fig 1-5, Fig 5-4] to request, view, print or download in near real time various reports relating to certificate parameters, issuance, redemption, and other information:

Optionally, an issuer may review existing parameters and data elements associated with a certificate or series of certificates [Fig 5-11]

Optionally, an issuer may review information about issued certificates [Fig 5-12].

Optionally, an issuer may review information about redeemed and/or revoked certificates [Fig 5-13].

An acquirer in a secure communication [Fig 6-3] with a certificate authority and by means of issuer facilities [Fig 1-4, Fig 6-2], has the means to to browse virtual certificates [Fig 6-5] assembled from the discrete elements stored on the database by a certificate authority, and to direct various parameters regarding issuance of a particular certificate and/or certificates [Fig 6-2].

Further means are provided for an acquirer to direct that available certificates be displayed on the basis of a particular store or brand of product, or on the basis of certificate types and/or issuer types categorized by one or more descriptors, as by type of store or type of product, or by other descriptive criteria available in the discrete information associated with each unissued virtual certificate.

Optionally, an acquirer may specify a geographic location of a available redeemer, for example, on the basis of a postal code or telephone number, which can be used by the certificate authority to screen available certificates such that only redeemable certificates associated with the specified geographic location are presented to the acquirer. For example, an issuer may have specified geographic exclusions for a certificate which correlate to the acquirer's geographic identification information, precluding redemption within the acquirer's geographic area.

Further means are provided [Fig 7-1] for an acquirer to direct a certificate authority to issue a certificate and/or certificates selected by the acquirer from the available certificates, in return for payment and/or on the basis of other qualification of the acquirer. An acquirer may upload other necessary instructions and information about the acquirer to the certificate authority, for storage as additional independent elements associated with an issued certificate. Elements uploaded in this process include name and address information [Fig 7-1], credit card or other information associated with the acquirer's payment agent [Fig 7-2], and assignment by an acquirer of the secret private key to be associate with a certificate [Fig 3-1, 7-5].

Optionally, an acquirer may specify that the private key [Fig 7-5] to be associated with an issued certificate be comprised of other identification information associated with the transaction [for example, an account number which associates the acquirer with the acquirer's payment agent, or a debit card number].

Optionally, an acquirer may select and/or specify [Fig 7-4] a denomination of a certificate [for example, a currency amount] by selecting from among denominations presented by an issuer.

Optionally, an acquirer may direct [Fig 7-6] the method of delivery of an issued certificate. Examples of delivery methods which may be specified by an acquirer include downloading of the certificate as an electronic file [for example, as an HTML document or PDF file or as an electronic description transferred via the acquirer's computer to a transaction card, or to the acquirer's computer either for near real time printing on a printer connected to the acquirer's computer or for subsequent printing later by the acquirer. A redeemer needs only the denomination of the certificate and the public key, in combination with the acquirer's private key, to validate a certificate. Hence an issuer may request that a certificate be delivered in the form of an email containing only these items, or as encodable "smart card" data that can be magnetically stored by the acquirer using a "smart-card" encoder attached to his computer or communication device.

Optionally, an acquirer may specify [Fig 7-6] that an acquired certificate be printed by the certificate authority and delivered by a postal/delivery service to an address specified by the acquirer.

Optionally, an acquirer may specify [Fig 7-6] that a facsimile image of an acquired certificate be delivered to a fax machine designated by the acquirer.

An acquirer is further provided the means [Fig 6-7] to cancel a certificate, or to request that an acquired certificate be revoked and replaced by a new certificate.

An acquirer is further provided the means [Fig 6-7] to query the secure database for available redemption locations for an acquired certificate, on the basis of a geographic screening.

A certificate redeemer [Fig 1-12] in selective electronic communication with a certificate authority [Fig 1-2] has the means [Fig 1-6, Fig 8-1]] to validate the denomination of a certificate

and obtain authorization from a certificate authority to redeem the certificate, by uploading [Fig 8-4] to the certificate authority the denomination, public key, and private key associated with a certificate to the the certificate authority.

Optionally, the communication of the required keys and denomination of the certificate to the certificate authority may be made by using a point-of-sale terminal and/or a bar-code scanner [Fig 1-13] , a computer [Fig 1-12], or by other means having the ability to establish an electronic link with the certificate authority.

Optionally, the communication of the required keys and denomination of the certificate to the certificate authority may be made using a touch tone telephone keypad [Fig 1-15], or by live phone contact to an operator intermediary in communication with the certificate authority.

Upon authentication of the certificate by the certificate authority in near real time [and implicitly, of the acquirer or a designated third party to whom the secret code has been communicated] on the basis of a correlation of the unique certificate identification in combination with the acquirer's PIN [provided by the acquirer] with the transaction records associated with the certificate stored on its secure database, the certificate authority authorizes the redemption, revokes the certificate, and sends instructions to it's payment agent to transfer funds to the payment agent of a redeemer, completing the transaction.

Optionally, upon authentication of a certificate, the certificate authority has the means [Fig 1-3] to create a unique redemption transaction code, which may be downloaded [Fig 8-5, Fig 1-17] or otherwise communicated to a redeemer, and which is stored with the data elements relating to the certificate. This identification code may be used subsequently by a redeemer to authenticate to the certificate authority that the redemption of the certificate occurred, in the event there are subsequent discrepancies in the final financial reconciliation of payment transfers associated with the transaction.

A certificate authority has the means [Fig 1-16] to selectively establish an electronic communication link with a acquirer's payment agent to request payment and transmits to the acquirer's payment agent the identification needed by a acquirer's payment agent to authenticate the acquirer and obtain approval for the transaction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 7,209,889

APPLICATION NO.: 09/472,100

ISSUE DATE : April 24, 2007

INVENTOR(S): Whitfield

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Please insert the following on the front page of the patent directly below filing date:

Related U.S. Application Data

Provisional Application No. 60/113,706, filed on Dec. 24, 1998.

Please insert the following paragraph heading and paragraph into the specification at column 1, line 5, immediately following the title:

CROSS-REFERENCE TO RELATED APPLICATIONS

The present application claims priority to U.S. Provisional Application No. 60/113,706, filed on Dec. 24, 1998.